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I
Introduction

Under the copyright law which was in effect until January 1, 1978, it was necessary to place a copyright notice on a published work in order to obtain copyright protection. If the notice was omitted from any substantial number of copies[1] the copyright was lost forever and could not be retrieved whether the omission was deliberate or inadvertent. Under the new law, the Copyright Act of 1976,[2] inadvertent omission of the copyright notice does not invalidate the copyright on a published work, subject to certain limitations. But the effect on the copyright if the notice is deliberately omitted is uncertain.

The uncertainty stems from the unclear wording of section 405(a)(2), which provides that an omission of notice can be cured if a reasonable effort is made to add notice to all copies that are distributed "after the omission has been discovered."[3] The problem involves the meaning of the word "discovery." The issue is whether one can "discover" one's deliberate omis-

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1. The definition of "copies" is set forth in 17 U.S.C. app. § 101 (1976): " 'Copies' are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term 'copies' includes the material object, other than a phonorecord, in which the work is first fixed."

2. 17 U.S.C. app. §§ 101-810 (1976).

3. An additional question can arise as to the date of the copyright if the copyright notice is deliberately omitted when the work is first published, and thereafter the work is distributed with a proper notice.

sion or whether the deliberate nature of the omission precludes the ability of one to discover it.

This article will discuss the effect of the deliberate omission of a notice of copyright in two situations: first, where the intent is to relinquish or abandon the claim to copyright and to place the work in the public domain, and second where the author, through ignorance or mistake, does not assert his rights. The article begins with a brief discussion of the history of the notice requirement in copyright law. After discussing the possible effects of deliberate omission of notice under the current law, the article examines the apparent conflict between the wording of the statute and the legislative history of the Act, which indicates that the statute-makers wanted to minimize the significance of the notice requirement.[4]

II
Significance of the Notice Requirement

Under common law, an author's rights in his work were lost when the work was published.[5] Later, as the idea of copyright developed, an author's rights in his published works were recognized if he gave notice to the world and followed certain specified procedures. Generally required was the filing, in some central repository, of a claim to copyright and inclusion of a notice of the author or successor's claim to copyright on the work. In the United States a copyright claim must be filed in the Copyright Office, a subdivision of the Library of Congress, and the copyright notice should be "Copyright 19XX, Author," or "© 19XX Author." In the case of certain works of art, greeting cards for example, the year of publication may be omitted[6] but the basic idea has been to give the public notice that the work is copyrighted.[7]

Over the years the broad idea of copyright has changed and gradually, many countries have developed the idea that an author's work is automatically protected for a certain limited time after its creation.[8] The United States is one of the very few countries still requiring that a creator give notice of his

4. *See infra* section IV, B of text, beginning after note 38.
5. *See* L. PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 16-17 (1968).
6. *See* 17 U.S.C. app. § 401(b)(2) (1976).
7. *See generally* 2 NIMMER ON COPYRIGHT § 7.08[A][1]-[2] (1982).
8. H.R. REP. No. 1476, 94th Cong., 2nd Sess. 135 (1976).

claim to copyright by the provision of a notice on the work.[9]

Nevertheless, it has long been recognized that in many cases a copyright notice has been omitted from a work which the author wishes to protect by copyright. Often the notice is unintentionally or inadvertently omitted and those drafting the new copyright law sought to protect the creators of such works.[10] However, determining what was in a creator's mind at the time of publication presents a difficult problem of proof. Unless the creator declares a deliberate intention to omit the notice it will not be clear whether an omission of the notice was deliberate or inadvertent. If the law provided for a cure of an inadvertant omission but not of a deliberate one it would seem that a creator who deliberately omitted notice but did not express his intention could later plead inadvertance to enable himself to cure the omission. The problem of determining the author's subjective intent was discussed in the course of earlier attempts to amend the Copyright Act.

In 1965, Abraham L. Kaminstein (who was then United States Register of Copyrights) commenting on the *Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law (July 19, 1961)* said:

> In the discussions of the *Report's* proposals (and of the 1963 preliminary draft which to some extent adopted them) it was urged that, to make the validity of a copyright turn on the question of whether the omission of notice was 'deliberate' or 'unintentional' would involve impossible problems of proof and would result in uncertainty and injustice. After considering these arguments we concluded that questions involving the subjective state of mind of one or more persons and their ignorance or knowledge of the law should be avoided, if at all possible. Assuming that it also contains proper safeguards to protect the public and thus keep the notice requirements from becoming meaningless, we decided that the Bill should drop any distinction between 'deliberate' and 'inadvertent' or 'unin-

9. 2 NIMMER ON COPYRIGHT § 7.02 (1982).

10. *See* legislative history of *General Revision of Copyright Law*, S. 22, 94th Cong., 2d Sess. (1976); S. REP. No. 94-473, 94th Cong., 1st Sess. (1975); H.REP. No. 94-1476, 94th Cong., 2d Sess. (1976); CONF. REP. No. 94-1733, 94th Cong., 2d Sess. (1976); 122 CONG. REC. (1976), *compiled in* 1976 U.S. CODE. CONG. & AD. NEWS 5659-5823. Excerpts from the history also appear in 17 U.S.C.A. § 405 (West 1981). An early draft copyright law revision bill was S. 3008, 88th Cong., 2d Sess. (1964). *See also* 2 KAMINSTEIN LEGISLATIVE HISTORY PROJECT: A COMPENDIUM AND ANALYTICAL INDEX OF MATERIALS LEADING TO THE COPYRIGHT ACT OF 1976 (Latman & Lighstone eds. 1981) [The Act is printed in full in 1976 U.S. CODE CONG. & AD. NEWS 2541-2602.]

tentional' omission [of the notice] and, subject to certain conditions, should preserve the copyright in all cases.[11]

The new Copyright Act, however, does not eliminate the distinction which Kaminstein sought to avoid.

The copyright notice requirement is set forth in section 401, and the effect of omission of the notice is set forth in section 405.[12] Section 405 provides that omission of the copyright no-

11. COPYRIGHT LAW REVISION. Part 6. Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill. House Committee Print, 89th Cong., 1st Sess. 105 (1965).

12. Section 401. Notice of copyright: Visually perceptible copies

(a) General requirement. Whenever a work protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.

(b) Form of notice. The notice appearing on the copies shall consist of the following three elements:

(1) the symbol © (the letter C in a circle), or the word "Copyright," or the abbreviation "Copr."; and

(2) the year of first publication of work; in the case of compilations or derivative works incorporating previously published material, the year date of the first publication of the compilation or derivative work is sufficient. The year date may be omitted where a pictorial, graphic, or sculptural work, with accompanying text matter, if any, is reproduced in or on greeting cards, postcards, stationery, jewelry, dolls, toys, or any useful articles; and

(3) the name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner.

(c) Position of the Notice. The notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright. The Register of Copyrights shall prescribe by regulation, as examples, specific methods of affixation and positions of the notice on various types of works that will satisfy this requirement, but these specifications shall not be considered exhaustive.

Section 405. Notice of copyright: Omission of notice

(a) Effect of Omission on Copyright. The omission of the copyright notice prescribed by sections 401 through 403 from copies or phonorecords publicly distributed by authority of the copyright owner does not invalidate the copyright in a work if—

(1) the notice has been omitted from no more than a relatively small number of copies or phonorecords distributed to the public; or

(2) registration for the work has been made before or is made within five years after the publication without notice, and a reasonable effort is made to add notice to all copies or phonorecords that are distributed to the public in the United States after the omission has been discovered; or

(3) the notice has been omitted in violation of an express requirement in writing that, as a condition of the copyright owner's authorization of the public distribution of copies or phonorecords, they bear the prescribed notice.

(b) Effect of Omission on Innocent Infringers. Any person who innocently

tice does not invalidate the copyright in a work if "registration for the work has been made before or is made within five years after the publication without notice, and a reasonable effort is made to add notice to all copies or phonorecords that are distributed to the public in the United States *after the omission has been discovered* . . . ."[13] Because of an unfortunate choice of words, the distinction between deliberate and unintentional omission is preserved, perhaps inadvertently, by the 1976 Act. Subsection (a)(2) of section 405 of the Act speaks of the omission of the notice as being "discovered," which implies an accidental or unknown omission.[14] This conflicts with the legislative history of the statute, wherein it was asserted that,

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infringes a copyright, in reliance upon an authorized copy or phonorecord from which the copyright notice has been omitted, incurs no liability for actual or statutory damages under section 504 for any infringing acts committed before receiving actual notice that registration for the work has been made under section 408, if such person proves that he or she was misled by the omission of notice. In a suit for infringement in such a case the court may allow or disallow recovery of any of the infringer's profits attributable to the infringement, and may enjoin the continuation of the infringing undertaking, or may require, as a condition of permitting the continuation of the infringing undertaking, that the infringer pay the copyright owner a reasonable license fee in an amount and on terms fixed by the court.

(c) Removal of Notice. Protection under this title is not affected by the removal, destruction, or obliteration of the notice, without the authorization of the copyright owner, from any publicly distributed copies or phonorecords.

13. 17 U.S.C. app. § 405(a)(2) (1976) (emphasis added).

14. It is a non sequitur to argue that a deliberate omission of the notice is a mistake that can be "discovered" later. THE OXFORD ENGLISH DICTIONARY 432 (Compact Edition, 1979) offers two primary meanings for the word "discover":

1. Uncovered; bare; having the head bare.
2. Made manifest; found out, revealed, divulged.

Also given are several definitions, one especially pertinent to this discussion, viz: To obtain sight or knowledge of (something previously unknown) for the first time.

Examples given of these usages are:

1727. "He sent out his long-boat to discover what I was." (SWIFT, GULLIVER, II, viii, 169).

1783. "We invent things that are new; we discover what was before hidden. Galileo invented the telescope; Harvey discovered the circulation of the blood." (H. Blair, Lect. Rhet. X).

1892. "The defendant Burton says he discovered that he had made a mistake," (SIR H.E. LOPES in *Law Times' Rep.* LXVII.).

Thus, while "mistakes" (e.g., unintentional omission of notice from a work) are things which can be "discovered," they must be (1) not previously known and (2) brought to sight (knowledge) for the first time. An omission that is intentional satisfies neither of these conditions.

[Editor's Note: Beacon Looms, Inc. v. S. Lichtenberg & Co., Inc., 552 F. Supp. 1305 (S.D.N.Y. 1982), was decided while this article was being printed. The Southern District Court of New York said in *Beacon* that, "the statute's use of the phrase 'after the omission has been discovered' clearly suggests that it is unintentional omission that

"[u]nder the proposed law a work published without any copyright notice will still be subject to copyright protection for at least five years, whether the omission was partial or total, unintentional or deliberate."[15]

III
Publication With Intent Not to Claim Copyright Protection

When an author creates a work "fixed in any tangible medium of expression," his work is protected under the present copyright law.[16] The author or his successor in interest, such as an employer or an assignee of the author's rights, may then disseminate the work and register the copyright on that work. Generally, copyright protection is desired, but in certain cases, it is not. Instead, the author may wish to forego copyright protection and place the work in the public domain so that it is available to everyone. For example, certain research and scholarly organizations do not wish copyright protection and want the work to be widely disseminated and made available without limitation to anyone.

The copyright status of a work published under such a procedure is unclear under the present statute. Prior to January 1, 1978, the right to secure copyright was lost if the work was published without the proper notice. Publishing without notice acted as a *forfeiture* of the right and cases based on the 1909 Act regarded this as terminating or ending the right.[17] The 1976 Act

§ 405 (a)(2) permits to be cured. Simply put, one cannot 'discover' an omission that has been deliberate." *Id.* at 1310.]

15. COPYRIGHT LAW REVISION, H.R. REP. No. 94-1476, 94th Cong., 2d Sess. 147 (1976).

16. 17 U.S.C. § 101. Definition of when a work is "fixed."

17. The sources consulted in our research speak of the right to copyright being terminated by,

Expiration (at end of the original term and its renewal period, if any),
Forfeiture (*ispo facto*, by law),
Abandonment (voluntary relinquishment of the right),
Dedication (purposeful disposition of the right),
Laches (careless handling of the copyright, its notice, etc.),
Annulment (involuntary relinquishment of the right),
Divestment (foreign Government "divestments" of U.S. copyrights).

See R. BOWKER, COPYRIGHT: ITS HISTORY AND ITS LAW 121 (1912). "There is no authority on the point, and it is difficult to say what amount of evidence the court would require as to the fact of a dedication of a copyright to the public." COPINGER & SKONE JAMES ON COPYRIGHT, INCLUDING INTERNATIONAL COPYRIGHT § 287 (F. JAMES & E. JAMES 10th ed. 1965). *Cf.* Rowell, C.J.O, in the "Who's Who in Canada" case; International Press Ltd. v. Tunnell, [1938] 1 D.L.R. 393, 410-411.

does not expressly provide for *dedication* or *abandonment* of a copyright. Apparently then, the publication of a work in which the notice is deliberately omitted neither forfeits nor abandons the copyright, but instead leaves the work in some indefinite status. It seems clear that if more than five years elapse after the first publication and the requirements for copyright have not been met (i.e., registration of the claim to copyright and application of the notice), then there is no copyright. But before five years have gone by, and absent an express abandonment, section 405 of the statute leaves uncertain the status of the work which has been published and on which the notice has been deliberately omitted.[18]

There are relatively few choices in deciding the status of such a work during the first five years after publication: first, the deliberate omission could be considered an express act of abandonment; second, the intent of the author could be disregarded; and third, the work could be given a "conditional" copyright.

If the first choice is adopted, deliberate publication of a work without a notice would be considered to constitute an express act of abandonment. But unless there is express proof of intent to omit the notice and forfeit the copyright, the problem

18. 17 U.S.C. § 405(a)(2). [Editor's Note: Beacon Looms, Inc. v. S. Lichtenberg & Co., 552 F. Supp. 1305 (S.D.N.Y. 1982), was decided while this article was being printed. In *Beacon*, the plaintiff asserted that § 405(a)(2) permits only unintentional omissions of notice to be cured. The defendant, on the other hand, argued that regardless of whether the omission was deliberate or unintentional, forfeiture of the copyright can be avoided if the copyright is registered within five years of publication without notice and "reasonable efforts" are taken to affix notice. *Id.* at 1310. Essentially, the defendant was arguing that § 405(a)(2) creates a "conditional copyright," as the authors suggest in this article. The court did not agree, holding that § 405(a)(2) relates solely to unintentional omissions. *Id.* at 1310. *See* editor's note, *supra* note 14. In effect, the court adopted the first choice suggested by the authors of this article—deliberate publication of a work without a notice would be considered to constitute an express act of abandonment. *Id.* at 1312.

The court in *Beacon* further suggests that where deliberate omission of notice is at issue, the number of copies distributed without notice is a key factor in determining whether the copyright has been forfeited. If the number of copies distributed is "relatively small," § 405(a)(1) is said to apply, precluding forfeiture. If numerous copies are published without notice, § 405(a)(2) is said to apply, resulting in forfeiture of the copyright. Indeed, § 405(a)(2) reasonably construed in light of § 405(a)(1) suggests this numerical distinction. However, now that two circuit court opinions are in conflict, the issue of deliberate omission of notice should be resolved by analysis of the legislative history. As the authors of this article demonstrate, reference to that legislative history indicates that the statute-makers wanted to minimize the significance of the notice requirement.]

that concerned Kaminstein would remain,[19] namely, how do we determine the intent of the author? Moreover, this status was found unsatisfactory under the 1909 Act and it is directly contrary to the intent of the framers of the Act that the distinction between the deliberate and intentional omissions should not be significant. This should not be the status of such a work.

The second possible status, to hold that the work is copyrighted for the full statutory period, would disregard the intent of the author unless the intent was expressly stated. This status is unacceptable because it is contrary to both the intent of the framers of the Act and to the express wording of the statute.

The third possible, and preferable, status gives the work a form of protection that might be termed a "conditional" copyright. Under this approach, a work published without notice would have copyright protection for the first five years after publication. If nothing is done by the author (or publisher) during those five years, any copyright protection would lapse and, in effect, the copyright would be void *ab initio*.[20] However, if during the five years the claim to copyright is registered and the notice is applied to those copies distributed thereafter, the copyright would be "validated"[21] and would be valid *ab initio*. Anyone who was misled by the lack of notice on an earlier copy would be protected as an "innocent infringer" under section 405(b) of the Act. This third possible status has the advantage that if an author wishes to sue for infringement of his conditional copyright, he must register before he can file suit in federal court on a copyright infringement claim.[22]

The Act requires that "validation" to perfect a copyright must occur within five years immediately after publication without notice.[23] During this five-year period, a cloud of doubt obscures the copyright's ultimate validity because the author's intent is, as yet, unknown. Failure to take any action during that five-year period results in the copyright being terminated. A truly inadvertent omission followed by attempts within five

19. *See supra* note 11.

20. Latin, meaning "[f]rom the beginning; from the first act; from the inception." BLACK'S LAW DICTIONARY 6 (rev. 5th ed. 1979).

21. Absent any definition or statement in the statute, the word "validation" is intended to describe the affirmative action that an author must take to perfect the copyright for the full statutory term of a work published without notice.

22. 17 U.S.C. app. § 411 (1976).

23. 17 U.S.C. app. § 405(a)(2) (1976).

years by the author to add notice to substantially all copies will validate the copyright.[24] There is, however, an issue as to whether validation can be effected during the five year period if the notice originally was deliberately omitted. Only one case has considered this point and in no case has there been a final adjudication.[25]

IV
The Statutory Language Conflicts with the Legislative Intent

A problem of statutory interpretation arises because the language used in section 405(a)(2) of the statute[26] is in apparent conflict with the intention of the drafters of the Act as expressed in the legislative history.[27] The possible ambiguity involves the meaning of the word "discovered" in the phrase "after the omission has been discovered." It is not clear who must discover the omission—the author, the publisher, or a third party (who might be an infringer).[28] Furthermore, there is an issue as to whether "discovery" occurs when the omission of the physical notice becomes known, or when the *legal effect* of the omission becomes known. It is also unclear whether a reasonable effort must be made to add notice to copies already distributed before the discovery of the omission or how fast efforts must be made to add the notice to copies distributed thereafter. Clearly, there are different schools of thought.

Professor Melville B. Nimmer in his authoritative work *Nimmer on Copyright* takes a position opposite that taken by the only case in point, *O'Neill Developments, Inc. v. Galen Kilburn, Inc.*.[29] Nimmer apparently believes that it is inappropriate for courts to examine the legislative history in construing the stat-

24. W. PATTON, AN AUTHOR'S GUIDE TO THE COPYRIGHT LAW 80 (1980).

25. The authors have also found no law review articles that discuss the point. [Editors Note: as discussed in notes 14 and 18, *supra*, Beacon Looms, Inc. v. S. Lichtenberg & Co. is another case which discusses the issue of deliberate omission of copyright notice. The court in that case came to a conclusion opposite that of the authors of this article.]

26. *See supra* note 9.

27. *See supra* notes 10 and 11.

28. An innocent infringer of a work published without notice would be protected by Section 17 U.S.C. § 405(b) for his acts committed before receiving notice of the claim to copyright. *See also* N. BOORSTYN, COPYRIGHT LAW § 8.14 (1981).

29. 524 F. Supp. 710 (N.D. Ga. 1981). [Editor's Note: Nimmer's position is supported by the court's opinion in Beacon Looms, Inc. v. S. Lichtenberg & Co., 552 F. Supp. at 1309-1312.]

ute because there is no ambiguity in the statutory language. In *O'Neill*, however, a Georgia federal district court considered Nimmer's viewpoint but found that there was an ambiguity in the language.[30]

A. Nimmer's Position

In *Nimmer on Copyright*, Professor Nimmer recognizes that Congress intended to provide for curing both unintentional and deliberate omissions of notice, but notes that this legislative intent is apparently contradicted by the reasonable effort requirement of the statute.[31] Nimmer observes that the

> clearly stated legislative intent would appear to be contradicted by the reasonable effort requirement in the statutory text. It can hardly be said that a deliberate omission of notice comports with the requirement that a reasonable effort be made to add notice to all copies . . . publicly distributed after the omission has been discovered.[32]

He adds

> At most it [deliberate omission] would appear to mean that notice may be deliberately omitted from the first copy . . . . If such omission was deliberate, it must be immediately known (or 'discovered'), and hence the deliberate omission of notice from any subsequent copies . . . would constitute a failure to use 'a reasonable effort' to add the notice to such subsequent copies . . . . No matter how clear the expressed legislative intent, it cannot be given effect where it contradicts an unambiguous statutory text . . . .[33]

Nimmer thus appears to take the position that deliberate early omission of notice prevents the later validation of the copyright by the later application of the notice and registration.

However, in a footnote,[34] Nimmer cites a Supreme Court case[35] which holds that the court may look to the legislative history of an act to determine the meaning of its language no matter how clear the words may appear on superficial examination. In that case, the Court held that a federal appellate court erred when, in discerning the meaning of the Federal Water Pollution Control Act, it excluded reference to the legis-

30. 524 F. Supp. at 713-14.
31. 2 NIMMER ON COPYRIGHT § 713[B][3] (1982).
32. *Id.*
33. *Id.*
34. 2 NIMMER ON COPYRIGHT § 7.13[b][3] n.45 (1982).
35. United States v. American Trucking Ass'n, 310 U.S. 534, 543-44 (1940).

lative history. The Court noted "When aid to construction of the meaning of words, as used in the statute, is available, there certainly can be no 'rule of law' which forbids its use, however clear the words may appear on 'superficial examination.' "[36] Certainly, there is ample ground here to examine the meaning of the language of section 405(a)(2).

Even Nimmer does not appear to be happy with his opinion that the courts can not, under such circumstances, look beyond the words of the statute to the intent of the framers of the legislation. In his review of the *O'Neill* case,[37] Nimmer sympathizes with the court but feels that it has done violence to the language of the statute. He also recognizes that the literal interpretation leads to different results between works published outside the United States and those published within the United States.[38]

B. Legislative History

Even a brief study of the Copyright Act of 1976 will indicate that the intent therein is to preserve to the author the rights he secures under the Act, and consequently, the Act should be interpreted with that in mind. Distinguishing between "deliberate" and "unintentional" omission of the notice is not the way to preserve these rights, particularly in light of the legislative history.

The legislative history of the general revision of the copyright law is the best source for determining what meaning should be given to the language used in this provision of the statute. Gleaned from the various reports of the history are the following points and observations respecting the meaning of the statutory language concerning omission of notice from a copyrightable work.

First, there is ample evidence that the statute-makers wanted to minimize the significance of the notice requirement, but not to eliminate it altogether.[39] Thus, in the design of the Act every effort was made to preserve the copyright as subsisting from fixation even if the notice is omitted altogether (provided, of course, that the creator takes certain prescribed remedial steps). This is one of the major changes in the frame-

36. *Id.*
37. 2 NIMMER ON COPYRIGHT § 7.13[B][3] (1982).
38. *Id.* at § 7.13[B][2].
39. *See supra* note 10.

work of copyright made by the new law. It is repeated several times in the legislative history that the provisions of section 405(a) should "make clear" that the notice requirements "are not absolute" and that unlike the 1909 Act "the outright omission of a copyright notice does not automatically forfeit protection and throw the work into the public domain."[40]

Thus, the statutory copyright is secured when the work is tangibly fixed. It is not *immediately* lost or forfeited when the work is published with or without notice. The drafters of the statute declared that this is true "even if the notice is omitted entirely," and regardless of whether the omission was "intentional or unintentional."[41]

These rules respecting omission of notice are new and represent "a major change in the theoretical framework of American copyright law,"[42] and will have "immediate practical consequences" in many cases.[43] One such consequence is that works published without notice, "whether the omission was partial or total, unintentional or deliberate,"[44] are still subject to statutory protection for at least five years. Therefore, copyright protection which is secured automatically when a work is fixed should not be lost when the work is published even if the notice is omitted—entirely, intentionally and deliberately.[45] Moreover, supporting the argument is the statute-makers' declaration that the reasons for the omission have no bearing on the copyright's validity.

C. The *O'Neill* Case

The problem of publication with deliberate omission of notice, under the provisions of the Act of 1976 is discussed in *O'Neill Developments, Inc. v. Galen Kilburn, Inc.*[46] This case has not yet been finally decided, but in a motion for a temporary restraining order, the federal district court[47] held that the

40. COPYRIGHT LAW REVISION, H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 146, 13136-8 (1976) CONF. REP. NO. 94-1733, 94th Cong., 2d Sess. contains no comments on section 405 of the bill, indicating there was no disagreement between the House and the Senate of this provision.

41. *Id.* at 147.

42. *Id.* at 146.

43. COPYRIGHT LAW REVISION, S. REP. NO. 473, 94th Cong., 1st Sess. 129 (1975).

44. *Id.* at 129.

45. *Id.* at 129-30.

46. *See supra* note 29.

47. Judge Orinda D. Evans, presiding.

deliberate omission of the copyright notice was not fatal to an action for copyright infringement.[48]

This case arose when O'Neill, a developer of office condominium projects, prepared a brochure describing and advertising one of its projects. This brochure, as originally published in February 1980, did not contain a notice of copyright. Later, Kilburn, a developer of a competing office condominium project, copied portions of O'Neill's brochure in a brochure which advertised Kilburn's competing development. O'Neill admitted it had not registered its copyright because it "had [no] reason to believe that any other person would attempt to copy these brochures." After learning of Kilburn's action, O'Neill began placing a notice of copyright on its brochures, and registered its claim to copyright.[49]

In the action for a temporary restraining order, the court considered Kilburn's argument that O'Neill had not complied with Title 17 U.S.C. section 405(a)(2) because it had not made "a reasonable effort . . . to add notice" to those copies distributed until after it learned of Kilburn's action.[50] The court considered Professor Nimmer's position that the defendant's discovered omission of notice cannot be cured without making a reasonable effort to add notice to every copy in circulation.[51] However, the court disagreed with Nimmer's view as being contrary to the clearly expressed congressional intent and held that O'Neill had cured the deliberate omission by complying with 17 U.S.C. section 405(a)(2) by including the notice on copies later distributed and by registering its claim to copyright.[52]

> Kilburn's argument turns on the meaning of the word "discover" in section 405(a)(2). Kilburn contends that O'Neill's omission was . . . intentional. . . . Kilburn then cites Professor Nimmer for the proposition that section 405(a)(2) is intended to apply primarily to inadvertent omissions of the copyright notice. . . . There is another possible interpretation of the word "discover," however. Congress could have intended that copyright owners could cure deliberate omissions by including a notice of copyright in those copies published af-

48. 524 F. Supp. at 715.

49. *Id.* at 712.

50. *Id.* at 713. Other examples of situations which were treated as publication without notice are: 17 U.S.C. § 406(b) (incorrect year date in notice); 17 U.S.C. § 406(c) (no name or date in notice).

51. 2 NIMMER ON COPYRIGHT § 7.13[B][3] (1982).

52. 524 F. Supp. at 715.

ter "discovery" of the fact that existence of a copyright has become an issue.[53]

After the above decision in the *O'Neill* case was rendered, Professor Nimmer commented on it as follows:

> If there is ambiguity in the statutory language, then O'Neill is certainly correct in its conclusion that resort to statements of legislative intent is proper. But to find ambiguity there must be at least two alternative meanings, each of which the language could reasonably bear. It is submitted that the court was in error in concluding that the statutory phrase "after the omission has been discovered" could reasonably mean after discovery of the fact that the copyright may be challenged or may be infringed, as *O'Neill* suggests. The word "omission" simply will not bear this meaning. It is the discovery of "the omission" of notice, not the discovery of the fact that the copyright may be challenged, which triggers the "reasonable effort" requirement. One can sympathize with the *O'Neill* court's effort to avoid copyright forfeiture, and still conclude that this was accomplished only at the price of violence to the statutory language.
>
> But if *O'Neill* is not followed, it would seem, then, that the above stated legislative intent to excuse deliberate omissions of notice can be given only the trivial effect of excusing notice from the first published copy or phonorecord, plus the somewhat more significant effect of excusing deliberate omissions of notice from all copies and phonorecords published outside of the United States provided the registration requirement is observed. This latter effect is not without significance in it that it largely undercuts the statutory requirement of Sections 401(a) and 402(a) requiring placement of notice upon copies and phonorecords published outside of the United States.[54]

While the *O'Neill* case is not final,[55] and other courts may have contrary opinions,[56] at the moment it seems quite possible that courts will hold that deliberate omission of the copyright notice does not cause the loss of copyright, if the work is

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53. *Id.* at 713, 714. "Courts do indeed have power in certain circumstances to revise statutes to conform them to clearly expressed legislative intent." *Id.* at 714.

54. 2 NIMMER ON COPYRIGHT § 7.13[B][3] (1982).

55. As of February 15, 1983, the case was still pending before Judge Evans.

56. [Editor's Note: Indeed, Beacon Looms, Inc. v. S. Lichtenberg & Co., 552 F. Supp. 1305 (S.D.N.Y. 1982), decided while this article was being printed, reached a decision contrary to *O'Neill* on the issue of whether the deliberate omission of copyright notice can be "discovered." *See id.* at 1310, 1311. Nevertheless, the *Beacon* court applied the facts of the case to § 405(a)(2) as construed by the *O'Neill* court, finding that the copyright was forfeited because the defendant had failed to make reasonable effort to cure the omission. *Id.* at 1311.]

registered within five years of the first publication. The requirement of making "a reasonable effort . . . to add notice to all copies . . . distributed . . . after the omission has been discovered"[57] may well be ignored or construed to mean discovery of the legal consequences of deliberate omission. If a publisher believes it is not necessary to place a notice on a work, or does not know it is necessary to place a notice, it may be difficult to establish when the "discovery" of the omission occurred.

In addition, a question might be raised as to who must discover the omission. The failure of the statute to specify more details of the required discovery certainly can be held to make the statute indefinite.

V
Conclusion

On the basis of the *O'Neill* case, it appears that deliberate omission of copyright notice and subsequent distribution with notice and registration within five years will neither act to invalidate a copyright nor cause a forfeiture. To the contrary, it appears that such action will validate a copyright. The court in *O'Neill* did not decide what would be the effective date of the validated copyright, but logic dictates that the copyright should relate back to the creation of the work.

It would be logical for the courts to hold that the requirements for discovery of the omission of notice are sufficiently vague and indefinite to place the meaning of the statute in doubt, and thus allow consultation of the legislative history. The legislative history, of course, would indicate that the intent of the author (or publisher) is of no importance, and that only validation of the copyright matters. As Mr. Kastenmeir noted in the 1976 Copyright Law Revision Report:

> One of the strongest arguments for revision of the present statute has been the need to avoid the arbitrary and unjust forfeitures now resulting from unintentional or relatively unimportant omissions or errors in the copyright notice. It has been contended that the disadvantages of the notice requirement outweigh its values and that it should therefore be eliminated or subsequently liberalized.[58]

57. 17 U.S.C. app. § 405(a)(2) (1976).
58. H.R. REP. No. 1476, 94th Cong., 2d Sess. 143 (1976).

It is our belief that the court in the *O'Neill* case reached the correct conclusion; however, it would seem preferable to have based the decision on the intent of the framers of the legislation as opposed to the inequitable results of the language of the statute.